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10/017,835	12/12/2001	Ernie F. Brickell	884.437US1	9613
21186 7590 07/22/2008 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
SHEER, CRISTINA O				
ART UNIT		PAPER NUMBER		
3685				
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07/22/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/017,835

**Applicant(s)**

BRICKELL ET AL.

**Examiner**

CRISTINA OWEN SHERR

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-22, 24-27, 29-44, 48 and 53-58 is/are pending in the application.
- 4a) Of the above claim(s) 4, 6-22, 24-26, 29-35, 40-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 27, 36-39, 44, 48 and 56-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to Applicants' amendment filed April 18, 2008. Claims 1, 3-22, 24-27, 29-44, 48, 53-58 are currently pending in this case. Claims 56-58 are newly added. Claim 47 has been currently canceled. Claims 1, 7, 13, 27, and 41 are currently amended. Claims 1, 3, 5, 27, 36-39, 44, 48, and 56-58 are currently under examination.

### ***Response to Arguments***

2. Applicant's arguments with respect to the claims, as currently amended have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The term "associated with the type of transaction, the at least two authentication mechanisms selected from known secrets, stored secrets, biometrics and combinations thereof," in claims 1 and 27 is a relative term which renders the claim indefinite. Specifically, the term "and combinations thereof" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

5. "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...". (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 27, 36-39, 44, 48, and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al (US 5,999,711) in view of Maritzen et al (US 20002/019816/Prov. App. 60/298,423).

8. Regarding claim 1 –

9. Misra discloses a method of providing an authentication service (e.g. abs; col 1 In 64-col 2 In 7), comprising:

with an authentication server, relating a user identity to a set of authentication mechanisms, the user identity belonging to a user ( e.g. col 1 In 64-col 2 In 7);

relating a type of transaction with a relying party to a level of authentication, the relying party reliant on the authentication service to authenticate the user before user access is provided to its service, program or information (e.g. col 2 In 61-col 3 In 9).

10. Misra does not disclose, but Maritzen does, the user or relying party selecting at least two authentication mechanisms to input from the set of authentication mechanisms according to the level of authentication associated with the type of transaction, the at least two authentication mechanisms selected from known secrets, stored secrets, biometrics and combinations thereof, wherein a flexible authentication process is provided; and authenticating the user identity through the at least two authentication

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mechanisms, wherein the user is granted or denied access to the service, program or information provided by the relying party. (e.g. prov. App. At pg 5, 1<sup>st</sup> full paragraph, - pg 6, 2<sup>nd</sup> full paragraph).

11. It would be obvious to one of ordinary skill in the art at the time the invention was made to combine Misra and Maritzen, since both are in the field of biometric authentication for secure transactions and motivated by the fact that having two biometric identifiers is more secure than having only one. Further, the instant application merely combines known elements to produce a predictable result.

12. Regarding claim 27 –

13. Misra discloses a method of providing an authentication service(e.g. abs; col 1 In 64-col 2 In 7), comprising:

with an authentication server, providing a list of supported authentication methods to authenticate at least one user; ( e.g. col 1 In 64-col 2 In 7);

receiving requirements for an authentication level from at least one relying party, the at least one relying party reliant on the authentication service to authenticate the at least one user before user access is provided to its service, program or information; (col 4 30-38).

14. Misra does not disclose, but Maritzen does receiving a selection of at least two authentication methods from the at least one user, the at least two authentication mechanisms selected from known secrets, stored secrets, biometrics and combinations thereof, wherein a flexible authentication process is provided and the selection can

include a subset of the list of supported authentication methods; (e.g. prov. App. At pg 5, 1<sup>st</sup> full paragraph, - pg 6, 2<sup>nd</sup> full paragraph)

receiving identification information for the at least one user; (e.g. prov. App. At pg 5, 1<sup>st</sup> full paragraph, - pg 6, 2<sup>nd</sup> full paragraph)

producing a portfolio associated with the at least one user, the portfolio comprising the list of authentication methods, each authentication method in the portfolio meeting the selection of the at least one user, each authentication method in the portfolio supported by an authentication system, the list of authentication methods meeting the requirements for the authentication level from the at least one relying party; and relating the identification information to the portfolio for the at least one user. (page 6 first full paragraph).

15. It would be obvious to one of ordinary skill in the art at the time the invention was made to combine Misra and Maritzen, since both are in the field of biometric authentication for secure transactions and motivated by the fact that having two biometric identifiers is more secure than having only one. Further, the instant application merely combines known elements to produce a predictable result.

16. Regarding claim 44 –

17. Maritzen discloses wherein two or more authentication mechanisms are chosen. (e.g. prov. App. At pg 5, 1<sup>st</sup> full paragraph, - pg 6, 2<sup>nd</sup> full paragraph).

18. Regarding claim 48 –

19. Maritzen discloses wherein at least one of the known secrets is interactive. (e.g. prov. App. At pg 5, 1<sup>st</sup> full paragraph, - pg 6, 2<sup>nd</sup> full paragraph, e.g. pin or social security number).
20. Regarding claim 56 –
21. Maritzen discloses wherein the known secret is selected from a password, identification number, family name, and combinations thereof. (e.g. prov. App. At pg 5, 1<sup>st</sup> full paragraph, - pg 6, 2<sup>nd</sup> full paragraph, e.g. pin and social security number).
22. Regarding claim 57 –
23. Misra discloses wherein the stored secret is selected from a digital signature key, smart card, card containing a fixed secret, and combinations thereof. (e.g. col 1 In 55-60, wherein the secure package is stored on a portable storage medium)
24. Regarding claim 58 –
25. Maritzen discloses wherein the biometric is selected from a fingerprint, retina, iris, palm print, facial structure, voice recognition, and combinations thereof. (page 6 fist full paragraph).
26. Claims 3, 36-39, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al (US 5,999,711) in view of Maritzen et al (US 20002/019816/Prov. App. 60/298,423) further in view of Saito et al (US 6,275,941)
27. Regarding claim 3 –
28. Misra and Maritzen disclose as discussed.
29. Saito discloses monitoring a series of authentications for the relying party to detect fraud. (e.g. col 10 In 45- col 11 In 5).

30. It would be obvious to one of ordinary skill in the art at the time the invention was made to combine Saito with Misra and Maritzen, since all are in the field of biometric authentication for secure transactions and motivated by the fact that having two biometric identifiers is more secure than having only one and that monitoring transaction history adds another layer of security. Further, the instant application merely combines known elements to produce a predictable result.

31. Regarding claim 5 –

32. Misra discloses limitation of performing the method above using a portable computer (portable computer = mobile input device) (E.g. col 2 ln 30-45).

33. Regarding claim 36 –

34. Saito discloses receiving notice of a potentially compromised authentication method in the portfolio; authenticating the at least one user using an authentication method already in the portfolio, but not using the potentially compromised authentication method; and revoking the authentication information for the potentially compromised authentication method in the portfolio associated with the at least one user. (e.g. col 10 ln 45- col 11 ln 5).

35. Regarding claim 37 –

36. Saito discloses monitoring authentication events for the at least one user; and detecting possible fraud for a suspect authentication method. (e.g. col 10 ln 45- col 11 ln 5).

37. Regarding claim 38 –



38. Saito discloses authenticating the at least one user using an authentication method already in the portfolio, but not using the suspect authentication method; communicating the possible fraud to the at least one user; and upon confirmation of fraud, revoking the suspect authentication method in the portfolio. (e.g. col 10 ln 45- col 11 ln 5).

39. Regarding claim 39 –

40. Saito discloses automatically revoking the suspect authentication method in the portfolio, wherein the possible fraud is potentially serious fraud. (e.g. col 10 ln 45- col 11 ln 5).

41. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

42. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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43. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

44. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA OWEN SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

45. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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46. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cristina Owen Sherr, AU 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685